

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANDREA COLLAVO

Appeal No. 2002-1069
Application No. 09/263,342

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a ski boot. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Delery	4,085,528	Apr. 25, 1978
Wittmann	5,411,278	May 2, 1995
Bleimhofer	5,505,011	Apr. 9, 1996
Olson et al. (Olson '833)	5,678,833	Oct. 21, 1997
Ostinet et al. (Ostinet)	5,718,067	Feb. 17, 1998
Perrissoud et al. (Perrissoud)	5,752,331	May 19, 1998
Borel	5,909,885	June 8, 1999
Olson et al. (Olson '526)	5,913,526	June 22, 1999

Claims 1 and 3 to 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Olson '833 or Olson '526 in view of Delery and Wittmann and Bleimhofer in further view of either Borel or Perrissoud.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claim 1 above in further view of Ostinet.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed December 4, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed November 6, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 9 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1, the sole independent claim on appeal, reads as follows:

A ski boot having an upper, a front, and an instep, wherein the upper comprises:

a shell (1) having sides made in plastic material of a variable volume, the shell closing over the foot and the instep by two overlapping flaps (16, 17) and provided with at least one device for closing and tightening (11, 12) comprising a portion integral with the shell corresponding to an internal side of the foot and a portion integral to the opposite side, external to the shell, the shell presenting zones (14, 16, 18) of different rigidities; and

a cuff (2) rotatably joined to the shell at two opposed points (3, 4) in the malleolar region, opening toward the front, provided with at least a closing and tightening device (22, 23) and presenting likewise zones made of materials of differing rigidity (19, 19a, 27, 28) including at least a more rigid zone and a lesser rigid zone,

wherein the sides of the shell (1) are made of a less rigid material permitting the support, on the sides of the shell, by a rigid heel zone (5) extending toward the front by a lateral oblique band (10, 13) at least to a tightening device (11) situated the most forward and which supports the tightening device (11), in that the cuff (2) presents a more rigid zone comprising two lateral flaps (19, 19a), by which the cuff is rotatably joined on the lateral bands of the shell, and to at least a collar (20, 21) having a rearward portion, and being connected to the flaps (19, 19a), and carrying the closing and tightening device (22), and in that the rearward portion of the collar is connected to the heel zone (5) of the shell by a joining component (24) having a rearward portion that resists tension and compression, wherein further, on each side of the boot, the oblique band (10, 13), the collar (20) and the joining component (24) form a rigid triangular framework assuring the kinematics of the boot.

In the rejections before us, the examiner set forth (answer, pp. 3-6) various changes to the in-line skate of either Olson '833 or Olson '526 that the examiner

considered to have been obvious to a person of ordinary skill in the art. However, even if all those changes were made to the in-line skate of either Olson '833 or Olson '526, it would not arrive at the claimed invention. The claimed invention is a "ski boot." The in-line skates of Olson '833 and Olson '526 are not ski boots and in the rejections before us in this appeal the examiner never determined that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the in-line skate of either Olson '833 or Olson '526 to be a ski boot. Thus, the examiner failed to establish a prima facie case of obviousness of the claimed subject matter.

Moreover, it appears to us that the examiner relied on hindsight in reaching the obviousness determination since the advantages of utilizing the claimed ski boot are not appreciated by the prior art applied by the examiner. Our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was

made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 9 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 9 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2002-1069
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Page 7

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